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MCDERMOTT WILL & EMERY LLP
600 13TH STREET, NW
WASHINGTON, DC 20005-3096

EXAMINER

FISCHER, MARK L

ART UNIT	PAPER NUMBER
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2627

NOTIFICATION DATE	DELIVERY MODE
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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 10/585,947	Applicant(s) EJIMA, NAOKI	
	Examiner MARK FISCHER	Art Unit 2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 1-8 and 10-20 is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 1-5,8 and 10-20 is/are rejected.
- 8) ☒ Claim(s) 6 and 7 is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☒ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. This case has been transferred from examiner Kim-Kwok Chu to examiner Mark Fischer.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 20, 2010 has been entered.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on March 17, 2010 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

Specification - Title

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Specification

5. The disclosure is objected to because of the following informalities:
 - (a) **Page 8, line 20:** “as following” should be --as follows--.

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Appropriate correction is required.

Claim Objections

6. Claims 2, 6, 12, and 20 are objected to because of the following informalities:
- (a) **Claim 2, lines 3-4:** “copy associated with copy permission number” should be --a copy associated with a copy permission number--.
 - (b) **Claim 6, last line:** “based on the result” should be --based on the result of the judgment--.
 - (c) **Claim 12, last two lines:** “to execute the repeating transmitting comprised in the content transmitting method according to Claim 11” should be --to execute the content transmitting method according to Claim 11-- in order to eliminate uncertainty as to exactly what parts of the method of claim 11 are being executed or not executed.
 - (d) **Claim 20, last two lines:** “to execute the steps of receiving and recording comprised in the content receiving method according to Claim 19” should be --to execute the content receiving method according to Claim 19-- in order to eliminate uncertainty as to exactly what parts of the method of claim 19 are being executed or not executed.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. **Claims 12 and 20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Claims 12 and 20 are each drawn to recording medium containing a computer program, where the recording medium can be transitory, i.e., is not explicitly limited as disclosed as only being non-transitory computer readable media (for example, a “signal” transmitted across a wire can contain a computer program, where the “signal” can be considered a “medium” (e.g., a medium by which two elements can communicate) by which “recording” is performed when the signal is used to communicate the computer program to another element in some part of a recording process); and therefore, fail(s) to fall within a statutory category of invention. Applicant should note that adding "non-transitory" to the claim to limit a claimed computer readable medium to being statutory would be acceptable.

A claim directed to a computer readable medium having stored thereon a computer program is non-statutory, where the computer readable medium can be a signal, a carrier wave, or a data structure, which are non-statutory as noted, infra.

A claim directed to a computer program itself, a signal, a carrier wave, or a data structure is non-statutory because it is not:

- (a) a process occurring as a result of executing the program, or
- (b) a machine programmed to operate in accordance with the program, or
- (c) a manufacture structurally and functionally interconnected with the program in a manner which enable the program to act as a computer component and realize its functionality, or
- (d) a composition of matter.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. **Claims 1-5, 8, and 10-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Kori et al. (JP 2000-339851 A using US 6836844 B1 as a translation) hereinafter Kori.**

Regarding claim 13, Kori discloses a content receiving apparatus (Fig. 6) which receives, from outside (received from 100S of Fig. 5), content of a first recording medium (Fig. 1: 100 or Fig. 5: 100S) that is digital copyrighted work (col. 4, lines 51-54: "a portion covered by copyright") including a plurality of content blocks (paragraph bridging columns 6 and 7: "data are made up of blocks" which are recorded on the disc 100), and records the content into a second recording medium (Fig. 6: 200),

wherein the plurality of content blocks are sequentially transmitted (e.g., by a transmitting unit 23 and/or 24 of Fig. 5), each of said content blocks being accompanied by copy control information (e.g., Fig. 2: CGMS) indicating copy permission of the content that is digital copyrighted work (col. 1, lines 51-58), content identification information (e.g., Fig. 2: ISRC found in content ID) identifying the content that is digital copyrighted work (col. 4, lines 27-31), and content status information (e.g., Fig. 2: start flag and end flag found in content ID) indicating to which part of overall content said each of the content block corresponds (col. 6, lines 30-38), the copy control information, the content identification information and the content status

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information being stored in the first recording medium (col. 4, lines 19-26: content ID and copy control information are attached to the information content recorded on CD 100), and

the content receiving apparatus (Fig. 6) comprises:

a receiving unit (e.g., 32 and/or 36) configured to receive said each of the content blocks, the copy control information, the content identification information and the content status information (col. 9, lines 28-37: 35 detects content ID and copy control information which indicates that the information was passed through 32); and

a recording unit (e.g., 43, 44, and/or 40) configured to record the content indicated by the content identification information into the second recording medium (200) based on the content status information within a range that does not exceed the copy permission number (see Fig. 8: step S7 and col. 11, lines 22-33), in the case where the copy control information indicates that the copy permission number is limited (Fig. 8: step S6) and

wherein the content status information indicates one of a head part, a central part and an end part of the content (col. 6, lines 30-38).

Regarding claim 14, Kori discloses the content receiving apparatus according to Claim 13, further comprising:

a memory unit (Fig. 6: 41) configured to memorize copy number table (e.g., Fig. 7: TB) that has recorded a cumulative number that has been acquired after the receiving unit received, for each of the content identification information, the content indicated by the content identification information, and recorded into the second recording medium by the recording unit (col. 8, line 52 to col. 9, line 12), wherein:

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said recording unit (i) refers to the copy number table memorized by said memory unit, (ii) reads out the cumulative number corresponding to the content identification information received by said receiving unit, and (iii) judges whether or not the read-out cumulative number does not exceed the copy permission number indicated by the copy control information received by said receiving unit (col. 11, lines 22-33), and

in the case where the read-out cumulative number does not exceed the copy permission number, said recording unit records the content into the second recording medium (col. 11, lines 22-33).

Regarding claim 15, Kori discloses the content receiving apparatus according to Claim 14, wherein said recording unit updates the cumulative number to be incremented by one, said cumulative number corresponding to the content identification information memorized by said memory unit, when confirming that the overall content is received, and recorded into the second recording medium, based on the content status information (Fig. 8: after end flag is detected in step S9, then “copy count = copy count - 1” in step S10 which is the equivalent of an increment by one in light of the count system used by Kori).

Regarding claim 16, Kori discloses the content receiving apparatus according to Claim 15, wherein said recording unit updates the cumulative number to be incremented only by one in the case where said recording unit has been able to confirm the status has been transferred in the order of the head part, to the center part and to the end part (Fig. 8: step S4 detects start flag of a head part, step S9 detects end flag of an end part; and col. 6, lines 30-38: center flags are “00”), said status being in the overall content indicated by the content status information corresponding to said each of the plurality of content blocks (paragraph bridging cols. 6 and 7).

Regarding claim 17, Karl discloses the content receiving apparatus according to Claim 15, wherein said recording unit updates the cumulative number to be incremented only by one, in addition to the confirmation by the content status information, in the case where all of the content identification information (e.g., ISRC) corresponding to said each of the plurality of content blocks is identical (paragraph bridging cols. 4 and 5: “if plural pieces of information content identified by the same ISRC end in 1 chorus, the copy may be regarded as complete”) (col. 11, lines 14-33: it is checked whether the ISRC of the blocks is identical to an ISRC in the copy history in the table TB, and makes decrement (equivalent to increment in light of the count system used by Kori) in such a situation that the end flag is detected when the ISRC is identical to that in table TB).

Regarding claim 18, Karl discloses the content receiving apparatus according to Claim 13,

wherein the content identification information (e.g., ISRC) is accompanied by a validity flag (e.g., CGMS bits B2 and B3 in Fig. 2; or e.g., copy number bits B4-B6 in Fig. 2) indicating whether or not the content identification information is valid data (i.e. whether or not the ISRC information is valid non-copy-wise (i.e. whether or not it is non-copy-able data); or i.e. whether the copy number is 0), and

the recording unit checks the validity flag, and in the case where the result indicates that the content identification information is invalid (i.e. not non-copy-able; or i.e. copy number is greater than 0 as checked in step S7 of Fig. 8), the recording unit records the content into the second recording medium (col. 11, lines 6-13: “If the CGMS information is “00” or “10” indicating that copying is permitted, the controller 40 starts a recording operation (step S3)”); or

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col. 11, lines 22-23: “If the copy permitted count is 1 or more, the controller 40 continues recording”).

Claims 1, 11, and 19 each have similar limitations as claim 13, and are rejected for the same reasons applied to claim 13.

Regarding claim 2, Kori discloses the content transmitting apparatus according to Claim 1, further comprising

a control unit (e.g., Fig. 6: 40) configured to judge whether or not content to be transmitted is copy associated with copy permission number (col. 11, lines 14-22: “the controller 40 searches the copy history information managing memory 41 on the basis of this ISRC to determine whether the copy history of this information content is stored in the table TB in the memory 41 (step S6)”),

wherein in the case where the content to be transmitted is judged as the copy associated with the copy permission number by said control unit (col. 11, lines 22-33: “If the past history is found in the table TB ...”, i.e., copy permitted count is present), said transmission unit transmits, for each of the plurality of content blocks, in parallel with said each of the content blocks, the copy control information, the content identification information and the content status information (CMGS, ISRC, start flag, and end flag are all transmitted together with the content blocks as already set forth in the rejection of claim 1), and in the case where the content to be transmitted is judged as not the copy associated with the copy permission number (col. 11, lines 34-47: “If the last history is not found in the table TB ...”, i.e., copy permitted count is not present), said transmission unit transmits, for each of the plurality of content blocks, in parallel with said each of the plurality of content blocks, the copy control information and the content

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identification information (CMGS and ISRC are both transmitted together with the content blocks as already set forth in the rejection of claim 1).

Regarding claim 3, Kori discloses the content transmitting apparatus according to Claim 1, further comprising

a content reproducing unit (Fig. 5: 21) configured to repeatedly read out, from the first recording medium, for each of the plurality of content blocks, the corresponding content block, the corresponding copy control information, the corresponding content identification information and the corresponding content status information (e.g., col. 7, lines 55-61: “the compressed digital audio signal with the content ID and the copy control information attached is supplied to the digital interface 24” which indicates that the content ID and copy control information was read out by unit 21)

wherein said transmission unit (e.g., Fig. 5: 23 and/or 24) transmits the content block, the copy control information, the content identification information and the content status information that have been read out by said content reproducing unit (col. 7, lines 48-54: “the content ID and the copy control information ... outputted along with the analog audio signal to ... an audio signal recording apparatus [e.g., Fig. 6]”); or col. 7, lines 55-61: “This compressed digital audio signal is outputted through the output terminal 24d”).

Regarding claim 4, Kori (under an interpretation A) discloses the content transmitting apparatus according to Claim 3, further comprising

a control unit (e.g., Fig. 6: 40) configured to generate a validity flag (e.g., CGMS) indicating whether or not the content identification information read out from the first recording

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medium is valid data (e.g., CGMS indicates whether the data on the recording medium is valid non-copy-wise (i.e. whether copy is not to be prohibited)),

wherein said transmission unit transmits the content identification information accompanied by the validity flag (both ISRC and CGMS are transmitted by either of 23 and 24 of Fig. 5 as previously discussed in the rejection of claim 3).

Regarding claim 5, Kori (under the interpretation A) discloses the content transmitting apparatus according to Claim 4,

wherein said control unit (40) judges (Fig. 8: step S2) whether or not read-out mode of the first recording medium used by said content reproducing unit is special reproduction (i.e., copy permitted reproduction that is special in that it involves the detection of start and end flags) and in the case where the read-out mode is the special reproduction (i.e. step S2 = copy permitted), said control unit (40) generates a validity flag (e.g., CGMS flags are generated whenever the watermark information is reproduced, such reproduction occurring during copying) indicating that the content identification information (IRSC) is invalid (e.g., col. 11, lines 6-13: CGMS flag of “00” or “10” indicates that data is invalid non-copy-wise (i.e. copy is not to be prohibited)).

Regarding claim 4, Kori (under an interpretation B) discloses the content transmitting apparatus according to Claim 3, further comprising

a control unit (e.g., Fig. 6: 40) configured to generate a validity flag (e.g., CGMS) indicating whether or not the content identification information read out from the first recording medium is valid data (e.g., CGMS indicates whether the data on the recording medium is valid copy-wise (i.e. whether or not it can be copied)) ,

wherein said transmission unit transmits the content identification information accompanied by the validity flag (both ISRC and CGMS are transmitted by either of 23 and 24 of Fig. 5 as previously discussed in the rejection of claim 3).

Regarding claim 8, Kori (under the interpretation B) discloses the content transmitting apparatus according to Claim 4,

wherein in the case where the validity flag indicating that the content identification information is invalid is generated (e.g., CGMS is “11”), said control unit makes the content identification information null data (Fig. 8: step S8: stop recording) (paragraph bridging cols. 10 and 11: if CGMS is “11”, then copy is prohibited and recording is disabled which can be considered making the data that was to be recorded into null data).

Regarding claim 10, Kori discloses the content transmitting apparatus according to Claim 1,

wherein the copy control information, the content identification information and the content status information are transmitted as a packet (the transmitted content have a start flag and an end flag, as already discussed in the rejection of claim 1; the start and end of the transmission is indicated by the flags, thus defining a transmission packet having a beginning and an end), and

said transmission unit (e.g., Fig. 5: 23 and/or 24) transmits, by including in the packet, a content identification information flag (e.g., CGMS) indicating whether the content identification information should be divided into two packets (i.e. the portion from start to end indicated by the start and end flags is one packet and the cipher is another packet) and transmitted or the content identification information should be compressed (compressed digital audio signal) and

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transmitted as one packet (i.e. the portion from start to end indicated by the start and end flags is one packet) (col. 8, lines 17-21: “according to the decision of the CGMS information attached to the digital audio signal and the decision for the destination unit made through the digital interface 24, it is determined whether to send cipher key information for decrypting the encryption”).

Regarding claim 12, Kori discloses a recording medium containing a program for transmitting content of a first recording medium which is digital copyrighted work including a plurality of content blocks, the program, when executed by a computer, being configured to cause the computer to execute the repeating transmitting comprised in the content transmitting method according to Claim 11 (col. 10, lines 53-57: “The processing shown in FIG. 6 is mainly executed by the controller 40” where the processing inherently requires a program in order to be carried out, and where the program inherently requires being stored on a recording medium in order for it to exist).

Claim 20 recites similar limitations as claim 12, and is rejected for the same reasons applied to claim 12.

Allowable Subject Matter

11. The indicated allowability of **claims 5, 8, 10, and 16-18, and canceled claim 9 (whose limitations are currently incorporated into claims 1, 11, 13, and 19)** is withdrawn in view of the newly discovered reference(s) to Kori et al. (JP 2000-339851 A). Rejections based on the newly cited reference(s) have been presented above in this Office action.

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12. **Claims 6 and 7** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. The following is a statement of reasons for the indication of allowable subject matter:

(a) **In regard to claim 6**, the prior art of record alone or in combination fails to teach or suggest the combination of the limitations of claims 4 and 6 with emphasis to the bolded/italicized portions of claims 4 and 6 provided below, in combination with the rest of the limitations of claims 1, 3, 4, and 6:

a control unit configured to generate a validity flag indicating whether or not the content identification information read out from the first recording medium is valid data,

wherein said transmission unit ***transmits the content identification information accompanied by the validity flag.***

wherein the content identification information includes a data sequence made of a plurality of data, and

said control unit ***judges whether or not the data sequence has been completely read out from the first recording medium by said content reproducing unit, and generates the validity flag based on the result of the judgment.***

(b) **Claim 7** is dependent upon claim 6.

Response to Arguments

14. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARK FISCHER whose telephone number is (571)270-3549. The examiner can normally be reached on Monday-Friday from 9:00AM to 6:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Thi Nguyen can be reached on (571) 272-7579. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark L Fischer/
Examiner, Art Unit 2627

/William J Klimowicz/
Primary Examiner, Art Unit 2627